

REMARKS

Claim 1-2, 11 and 31 have been amended. Claims 34-36 have been added. Claims 13-30 have been cancelled. Claims 1-12 and 31-36 are pending in the application.

In this Response, Applicants have cancelled claims 13-30 from further consideration in this application. Applicants are not conceding that the subject matter encompassed by claims 13-30 is not patentable. Claims 13-30 were cancelled in this Response solely to facilitate expeditious prosecution of the remaining claims. Applicants respectfully reserve the right to pursue additional claims, including the subject matter encompassed by claims 13-30, as presented prior to this Response in one or more continuing applications.

Claims Rejections - 35 USC 103(a)

The Examiner rejected claims 1-33 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,526,042 (*Pinard*) in view of U.S. Patent No. 5,617,539 (*Ludwig*). Applicants respectfully traverse this rejection.

For ease of illustration, claim 1 is discussed first. Claim 1, directed to a method, describes (1) receiving information associated with an initiated telephone call that has been placed by a first party to a second party, (2) allocating a storage space that is accessible by at least the first party and the second party based on at least a portion of the received information, and (3) allowing at least one of the first party and second party to exchange one or more electronic files with the other party using the storage space. By allowing dynamic allocation of storage space based upon information associated with a telephone call, for example, on-the-fly file exchange between two unfamiliar parties may occur by initiating a phone call.

Applicants respectfully assert that ***Pinard***, ***Ludwig***, and/or their combination do not teach or disclose all of the elements of claim 1 of the present invention. In making an obviousness rejection, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. *KSR Int'l Co. v. Teleflex, Inc.*, at 14, No. 04-1350 (U.S. 2007). Applicants respectfully submit that the Examiner has not met this burden. If fact, as illustrated below, ***Pinard*** and ***Ludwig*** are incompatible, and consequently those skilled in art would not combine them and make all of the elements of claims of the present invention obvious. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established in rejecting claims 1-33.

It is well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986). It is also well established that where a modification or combination renders a prior art reference inoperable for its intended purpose, the reference teaches away from the modification or combination. *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984). That is, if the proposed combination undermines the purpose of the prior art, it cannot be obvious. Here, the Examiner proposes modifying ***Pinard*** with the teachings of ***Ludwig*** that would render inoperable the functionality taught in ***Pinard***. ***Pinard*** teaches a storage space that is accessible by a single party (*i.e.*, the email storage space of the second party is not accessible by the first party). *See Pinard*, col. 2. In contrast, ***Ludwig*** teaches that a group of users access a shared storage space in order to create, edit and review multimedia files. *See Ludwig*, Fig. 31B (Storage Medium). A reading of ***Ludwig*** makes plain that combining a system that has storage sharing capabilities with ***Pinard*** would render

inoperable any individual storage functionality of an email storage system. Thus, modifying the private storage teaching from *Pinard* with the shared storage teaching of *Ludwig* would defeat the private functionality taught in *Pinard*. As such, the two cited references have incompatible teachings, and thus cannot be used as a prior art basis against the claims of the instant Application.

The Examiner's rejection also fails because *Pinard* and *Ludwig*, either alone or in combination, do not teach all of the claimed features. For example, the cited references at least do not teach the claimed feature of receiving information associated with an initiated telephone call that has been placed by a first party to a second party. The Examiner argues this claimed feature is taught in *Pinard* (see Office Action, p.3), because *Pinard* discloses that an email is received (from a first party to a second party) containing a link that, if clicked, will then attempt to initiate a call from the second party to the first party. The Examiner's citation to *Pinard* actually demonstrates that this reference does not disclose the claimed feature. In particular, this reference teaches that when the link is received, there is no initiated telephone call, as called for in claim 1. *Pinard* teaches that, when the email and associated link (information, according to the Examiner) are received by the second party, there is the *possibility* of a telephone call in the future, but there is *no initiated telephone call* when the information is received, as called for in claim 1. As such, *Pinard* does not teach the claimed feature of receiving information associated with an initiated telephone call involving a first party and a second party, and *Ludwig* fails to remedy the deficiencies of *Pinard* with respect to this claimed feature.

Pinard and *Ludwig*, either alone or in combination, also fail to teach the claimed feature of allocating a storage space that is accessible by at least the first party and the second party based on at least a portion of the received information. The Examiner argues that *Pinard* teaches

this feature (*see* Office Action, p.4) because *Pinard* discloses a database 26 that stores emails sent to a second party. *Pinard*, however, teaches that email messages are sent to the second party and stored by the database for the second party. *See Pinard*, col. 2:13-16 & 2:39-44 (explaining how database 26 contains the existing emails of the second party and how the mail server 22 receives a new email directed to the second party and stores the new email in the database 26 where the *second party* may later retrieve the email (emphasis added)). *Pinard* does not teach, and in fact does not even suggest, that the first party (sending the email to the second party) has access to the second party's email storage space. In contrast, claim 1 calls for a storage space that is accessible by both the first party and the second party. *Ludwig* fails to remedy the deficiencies of *Pinard* with respect to this claimed feature.

Accordingly, for at least the aforementioned reasons, claim 1 and its dependent claims are allowable. For similar reasons, claim 31 and its dependent claims are also allowable.

Claim 8 is also allowable for additional reasons. For example, claim 8, depending from claim 1, calls for accessing caller identification information associated with the telephone call. The Examiner argues that this claimed feature is taught in *Pinard*. *See* Office Action, p.5. *Pinard*, as discussed above with respect to claim 1, does not teach information associated with the telephone call. As such, *Pinard* cannot teach caller identification information associated with the telephone call because when the email and link (information, according to the Examiner) are received by the second party, there is no call. In contrast, claim 8, by extension of its dependency from claim 1, specifically calls for an initiated telephone call that has been placed. *Ludwig* fails to remedy the deficiencies of *Pinard* with respect to this claimed feature.

With respect to the claimed feature of receiving the information comprises at least one of receiving the information provided by the service provider, the Examiner argues that this claimed

feature is also taught in *Pinard*. See Office Action, p.5. *Pinard* teaches that if the second party clicks on the link in the email sent from the first party, the first party's phone number or Internet address are retrieved and a call is initiated from the second party to the first party. See *Pinard*, col. 2:45 to col. 3:2. The Examiner's position, in his arguments with respect to claim 1, is that the email and link sent in *Pinard* from the first party to the second party correspond to the claimed feature of "information." Thus, under the Examiner's application, *Pinard* teaches that the *first party* provides the email and link (information, according to the Examiner) to the second party, not the service provider. See *Pinard*, col.2:20-22 (stating "In operation, the first party 10 sends an e-mail message, from the computer 14, via the network 16 to the second party 12 via mail server 22."). In contrast, claim 8 calls for receiving the information provided by the service provider.

To the extent the Examiner is arguing that the retrieved phone number and Internet address of the first party correspond to the claimed feature of "information" (contrary to the Examiner's position in his arguments with respect to claim 1), *Pinard* still fails to teach the claimed feature of receiving the information provided by the service provider. Because claim 8 depends from claim 1, the elements of claim 8 must be read in context with the elements of claim 1. Thus, claim 8 calls for the information received by the service provider to be used in conjunction with the "allocating" feature of claim 1 to "allocat[e] a storage space...based on at least a portion of the received information." However, *Pinard* does not disclose that the Internet address or telephone number are used to "allocate" a storage space. *Pinard*, as cited by the Examiner, teaches that after the phone number or Internet address are retrieved, control software 23 on a web server 20 determines if the call takes place over a computer network or a telephone network. See *Pinard*, col. 2:59-67. Because *Pinard* does not teach that retrieved phone number

and Internet address are used to “allocate” a storage space, the retrieved phone number and Internet address cannot correspond to the information received by the service provider called for in claim 8, as argued by the Examiner. As such, *Pinard* does not, and cannot, teach the claimed feature of receiving the information comprises at least one of receiving the information provided by the service provider, and *Ludwig* fails to remedy the deficiencies of *Pinard* with respect to this claimed feature. Accordingly, for at least the aforementioned reasons, claim 8 is allowable.

Claim 10 is also allowable for additional reasons. For example, claim 10, depending from claim 1, calls for the act of allocating comprises creating an electronic folder associated with each of the first party and the second party and further associating the two electronic folders with each other. By way of a non-limiting example, the sharing of folders may include cross-linking the folders such that items placed in one folder by a call participant can be mirrored into the folders of the other call participants. See Specification, p.16, ll.16-20. The Examiner argues that *Ludwig* teaches this claimed feature (see Office Action, p.6), but the Examiner’s particular position on this claimed feature is not clear. The Examiner cites text over three columns of the *Ludwig* reference (*Ludwig* col. 33:48 to col. 35:46), but he does not point to any specific teachings or make any specific arguments with respect to this claimed feature. See Office Action, p.6. It is clear, however, that *Ludwig* at least does not teach the claimed feature of further associating the two electronic folders with each other. The cited passage in *Ludwig* teaches Multimedia Conference Recording (MMCR), Multimedia Mail (MMM), Multimedia Document Management (MMDM) and Classes of Collaboration involved in MMCR, MMM & MMDM. See *Ludwig*, col. 33:48 to col. 35:46 (as cited by the Examiner). These teachings disclose creation and storage of multimedia documents, review and modification of such documents, as well as searching stored multimedia documents. See *id.* at col. 34:50 to col. 35:3.

The disclosure in *Ludwig* of the MMCR, MMM, MMDM and Classes of Collaboration, however, is silent with respect to associating two electronic folders with each other, as called for in claim 10. As previously stated, By way of a non-limiting example, the sharing of folders may include cross-linking the folders such that items placed in one folder by a call participant can be mirrored into the folders of the other call participants. *Ludwig* offers no teachings or disclosures along these lines. *Pinard* fails to remedy the deficiencies of *Ludwig* with respect to this claimed feature. Accordingly, for at least the aforementioned reasons, claim 10 is allowable.

Claim 35 is allowable for additional reasons. Claim 35 calls for the method of claim 34, wherein the first party and the second party each subscribe to a service that allocates the storage space, wherein allocating the storage space comprises allocating dynamically in response to determining that the first and second parties are authorized subscribers. By allocating storage space only to users who are authorized subscribers, for example, on-the-fly file exchange between two unacquainted parties may occur, by initiating a phone call, in a more secure manner. *Pinard* and *Ludwig* are silent with respect to this claimed feature. *Pinard* teaches storing emails received by a second party from a first party in an email server and initiating a call to first party if content within the email is clicked. See *Pinard*, col. 3. *Pinard* teaches that the first party (sending the email) has an associated webpage/java tools that provide the second party (receiving the email) the contact number to the first party. As such, the first party receiving the email is not an authorized subscriber to a service that dynamically allocates storage space, because no space is allocated by the webpage/java tools. The second user is not a subscriber to the email feature used by the first party, as called for in claim 35. Thus, *Pinard* does not teach allocating storage space, by a service, in response to determining that the parties are authorized subscribers to the service, as called for in claim 35.

Ludwig teaches a centralized server that allows users to access files, but similarly does not teach allocating space in response to determining that the parties are authorized subscribers to a service. *Ludwig* teaches that users are part of a network in which the users already have access to the stored data on the central server (*i.e.*, there is no allocation based upon users being authorized subscribers because *Ludwig* is not concerned with the concept of authorized subscribers to a service).

Accordingly, for at least the aforementioned reasons, claim 35 is allowable. For similar reasons, claim 36 is allowable.

Applicants respectfully assert that in light of the amendments and arguments provided throughout the prosecution of the present application, all claims of the present application are allowable and, therefore, request that a Notice of Allowance be issued. Reconsideration of the present application is respectfully requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the Houston, Texas telephone number (713) 934-4064 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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